UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,443	11/21/2003	Chris Bradford	EL-8218	8058

23453 7590 09/21/2004

RHEOX, INC.
WYCKOFFS MILL ROAD
P O BOX 700
HIGHTSTOWN, NJ 08520

EXAMINER	
GREEN, ANTHONY J	

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/717,443	BRADFORD ET AL.	
	Examiner	Art Unit	
	Anthony J. Green	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-5,7-10,12-21,23-25,27-30 and 32 is/are rejected.

7)☒ Claim(s) 6,11,22,26 and 31 is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4-5,14-17, 19-21, 24-25, 27, 29-30 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is confusing as it appears to refer to a process step however claim 1 is directed to a formulation.

In claim 5, part (c) the phrase "under the conditions of use in making these paint formulations" is confusing and vague and indefinite. What exactly is applicant trying to say?

In claim 14, part b) the phrase "the treated mixture" appears to lack proper antecedent basis.

In claim 16, part b) the phrase "the treated mixture" appears to lack proper antecedent basis.

In claim 19 the phrase "the batch making process" lacks proper antecedent basis.

Claim 19-21 are confusing as they appear to refer to a process whereas claim 18 is directed to a formulation.

In claim 24 the phrase "the batch making process" lacks proper antecedent basis.

Claim 24-25 and 27 are confusing as they appear to refer to a process whereas claim 23 is directed to a formulation.

In claim 29 the phrase "the batch making process" lacks proper antecedent basis.

Claim 29-30 and 32 are confusing as they appear to refer to a process whereas claim 28 is directed to a formulation.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 4-5, 8, 10, and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Coutelle et al (US Patent No. 5,582,638).

The reference teaches, in the examples, the formation of various compositions such as paints, comprising at least one synthetic phyllosilicate and at least one organic phosphorus compound as an additive.

The instant claims are met by the reference as the reference teaches compositions that encompass that which are instantly claimed.

6. Claims 2-3, 7, 9, 15-21, 23-25, 27-30 and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Coutelle et al (US Patent No. 5,582,638).

The reference was discussed previously. While the reference does not teach the use of calcium hectorite or sodium hectorite it does broadly teach the use of a synthetic hectorite and accordingly one of ordinary skill in the art would have found it obvious to use any type of hectorite without producing any unexpected results thus rendering obvious instant claims 2-3, 7,9, and 15. As for when and/or how the additives are added, since these are process limitations which depend on a composition claim they are considered to be product be process limitations and accordingly it is known that "Product-By-Process claims do not patentably distinguish the product of reference even though made by a different process". See In re Thorpe 227 USPQ 964. Thus claims 19-21, 24-25, 27, 29-30 and 32 are rendered obvious. As for independent claims 18, 23 and 28, it is the position of the examiner that it would have been obvious to utilize the composition of the reference in any type of paint formulation along with their customary additives as the reference broadly teaches the use of a paint formulation.

7. Claims 1, 4-5, 8, 10, and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Ijdo et al (US Patent Application Publication No. 2004/0016369, 2003/0047117 and 2002/0144630).

The applied references have a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The claims and example 11 of the references teach compositions that encompass that which is instantly claimed.

8. Claims 2-3, 7, 9, 15-21, 23-25, 27-30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ijdo et al (US Patent Application Publication No. 2004/0016369, 2003/0047117 and 2002/0144630).

The references were discussed previously. While the references do not teach the use of calcium hectorite or sodium hectorite they do broadly teach the use of a hectorite clay and accordingly one of ordinary skill in the art would have found it obvious to use any type of hectorite without producing any unexpected results thus rendering obvious instant claims 2-3, 7,9,and 15. As for when and/or how the additives are added, since these are process limitations which depend on a composition claim they

are considered to be product be process limitations and accordingly it is known that "Product-By-Process claims do not patentably distinguish the product of reference even though made by a different process". See In re Thorpe 227 USPQ 964. Thus claims 19-21, 24-25, 27, 29-30 and 32 are rendered obvious. As for independent claims 18, 23 and 28, it is the position of the examiner that it would have been obvious to utilize the compositions of the references in any type of paint formulation along with their customary additives as the references broadly teaches the use of a paint formulation comprising the hectorite and phosphonate compound.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-5, 7-21, 23-25, 27-30 and 32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/620,617 (US Patent Application Publication No. 2004/0016369). Although the conflicting claims are not identical, they

are not patentably distinct from each other because the reduction to practice of the claims of the previous patent application would render obvious the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The instant claims are of a narrower scope than those of the prior application and therefore they are encompassed by those claims absent evidence showing otherwise. Applicants other Patent Publications which were used in the above 102(e) rejection have not been used in this obviousness type double patenting rejection as they have been abandoned and accordingly no patent could ever issue from those other applications.

Allowable Subject Matter

11. Claims 6, 11, 22, 26 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

References Cited By The Examiner

12. The remaining references are cited as showing the general state of the art and as such, they are not seen to teach or fairly suggest the instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
September 17, 2004